

REMARKS

Applicant requests favorable reconsideration and withdrawal of the rejections set forth in the above-mentioned Office Action in view of the foregoing amendment and the following remarks.

Claims 20, 21, 24, 25, 28, 29, and 32-34 remain pending, of which claims 20, 24, and 28 are independent claims. Claim 24 has been amended. Support for the amendment can be found throughout the originally-filed disclosure. Thus, Applicant submits that the amendment does not include new matter.

Section 112 Rejection

Claims 20, 21 and 32 are rejected in the Office Action under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action asserts that the phrase “font with the thinnest weight in the specified typeface” is not described in the originally-filed disclosure, and thus, this phrase in the claims constitutes new matter. In setting forth the rejection, the Office Action asserts that the specification discloses a system that chooses certain fonts that are more intelligible than other fonts in a certain size, but that a relationship between weights, fonts, and intelligibility is not found in the originally-filed disclosure.

Applicant again respectfully traverses this rejection, and submits that the originally-filed disclosure includes a written description of the claimed features, including the recited features relating to the weight of a font, so as to satisfy the written description requirement of Section 112.

As discussed in the previous Amendment, the originally-filed describes how an intelligible font is selected in relation to a font weight. In one example discussed at page 33, line 27 through page 34, line 5 of the specification, it is noted that “Mincho typeface W5” is used when a font size is greater than 5 point, but is replaced with “Mincho typeface W3” when the font size is equal to or greater than 4 point but less than 5 point. This example goes on to note that when a font size of less than 4 point is used, the font is replaced by “Gothic typeface W3” because Mincho typeface W3 is not intelligible at such a font size.

Applicant respectfully submits that *one of ordinary skill in the art* would readily recognize such a disclosed selection of a font includes selecting a thinner font weight based on the font size. The terms “Mincho typeface W3,” “Mincho typeface W5,” and “Gothic typeface W3,” are terms of art, not merely terms drafted for the present application. In this regard, one of ordinary skill in the art would recognize that the typefaces “Mincho” and “Gothic” have clearly defined meanings, and that the designations of “W3” and “W5” indicate different thicknesses within the typefaces. More particularly, one of ordinary skill in the art would recognize that, for a given typeface, a “W3” font is thinner than a “W5” font. Thus, one of ordinary skill in the art would know, based on the use of this art-terminology, that “Mincho typeface W3” and “Mincho typeface W5” both designate a font with the same typeface (Mincho), but that the “W3” font is of thinner weight in that typeface than the “W5” weight. Further, as Mincho typeface is by definition thicker at a

given font size than Gothic typeface, one of ordinary skill in the art would recognize that “Mincho typeface W3” is thicker than “Gothic typeface W3.”

As evidence that one of ordinary skill in the art would readily understand the meanings of these terms of the art, including the fonts thicknesses, Applicant has enclosed three references, which use the same terminology as the present application, and further graphically illustrate that the relationships between the fonts. Specifically, the reference “Font Gallery” by Canon, Inc., illustrates different typefaces, including Mincho and Gothic, with each typeface having different thicknesses indicated with the designations W3, W5, W7, and W9. As can be seen from the illustrations in this reference, “W3” of a given typeface is thinner than “W5,” and “W5” is thinner than “W9.” The reference “Japan Typography” by Typo Magazine notes that in font terminology, “thickness is marked with the aid of a scale from W1 to W12, i.e. from the thinnest to the thickest typeface.” P. 1. Further, the different typefaces have different thicknesses, i.e., Mincho W3 is thicker than Gothic W3. The reference “A Guide to Japanese Typefaces” clearly illustrates typefaces using designations such as “W3,” “W4,” “W9,” etc., with the smaller numbers indicating thinner weights. Further, this reference demonstrates that the typefaces “Mincho” and “Gothic” have clearly defined meanings. Thus, Applicant submits that the enclosed references clearly demonstrate that the terminology used in the present application with respect to fonts is terminology used in the art, and as such, one of ordinary skill in the art would recognize the designation of thicknesses based on the terminology.

In responding to Applicant's previous Remarks, the Office Action posits a series of questions, including where in the specification it is indicated, or how would one otherwise know, that Mincho typeface W3 is considered thicker than Gothic typeface W3. The answer to this question, as indicated above, is that one of ordinary skill in the art would know that Mincho typeface W3 is thicker than Gothic typeface W3 because these are terms of the art with clearly defined meanings. That is, Mincho typeface W3 is by definition thicker than Gothic typeface W3 at a given font size.

With the above-discussion in mind, Applicant again submits that the originally-filed disclosure provides an ample written description of the claimed font weight features so as to satisfy the requirements of Section 101. For example, Figure 19 shows a table for replacement fonts. According to the table, in the case where the Mincho typeface W5 is specified at the time of printing and the font size is equal to or greater than 5 point, the Mincho typeface W5 font is used in the print operation. On the other hand, if the font size is equal to or greater 4 point but less than 5 point, the Mincho typeface W5 font is replaced by the Mincho typeface W3 because line thickness of the Mincho typeface W5 can hinder intelligibility. Further when the size is less than 4 point, the Mincho typeface replaced by the Gothic typeface W3. This clearly demonstrates to one of ordinary skill in the art the claimed relation between font size and font weight. Again, it is important to note that the indicated fonts are terms of art that would be readily recognized by one of ordinary skill in the art, and as such, implicitly indicate differing thicknesses.

In sum, Applicant submits that the originally-filed disclosure with its detailed discussions of the selection of fonts using art-recognized terminology, would readily be understood by one of ordinary skill in the art to include all of the features of the claimed invention, including the selection of fonts font with based on their weight. Thus, the requirements of Section 112, first paragraph are met.

Section 101 Rejection

Claims 24, 25, and 33 are rejected in the Office Action under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

In response, Applicant has clarified the statutory subject of these claims by amending independent claim 24 to recite that the steps recited in the claimed method are performed by a document processing system. Applicant submits that the recited method is now clearly tied to another statutory category, namely a product-machine. Thus, the method claims recite statutory subject matter under Section 101.

In the event, however, that the Office still deems these claims not to satisfy the requirements of Section 101, Applicant would greatly appreciate any suggestions as to how these claims could be amended in a manner to clarify the statutory subject matter under Section 101.

Section 103 Rejection

Claim 20 is rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over Cedar et al. (U.S. Patent No. 6,256,650) in view of Hino (U.S. Patent Application Pub. No. 2002/0036788), Yudasaka et al. (U.S. Patent Application Pub. No.

2003/0202211), and Sakurai (U.S. Patent No. 5,562,350). Claims 24 and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cedar et al. in view of Hino and Yudasaka et al. Claims 21 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cedar et al. in view of Hino, Yudasaka et al., Sakurai, and Hertzfeld (U.S. Patent No. 6,441,824). Claims 25, 29, 33, and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cedar et al. in view of Hino and Yudasaka et al., and Hertzfeld.

Applicant respectfully traverses the rejections, and submits that the claimed invention is patentably distinguishable from the cited references for at least the following reasons.

In formulating the rejections, the Office Action cites Cedar et al. as disclosing a selection unit that can select a font with the thinnest weight in a specified typeface if the font size is smaller than a first size and is larger than or equal to a second size. In particular, the Office Action asserts that Cedar et al. discloses that a user can change the font size of Arial text from its current font size to the smallest font size on the system using Rich formatting. The Office Action further asserts that this change of font size would thereby change the weight of the current font to the thinnest possible weight.

Applicant respectfully submits that Office Action's citation to a user changing a font size does not equate to the feature of the claims that it is cited as anticipating, either expressly or inherently.

In this regard, the Office Action maybe misunderstanding certain features of a fonts. A “font” includes a certain typeface and weight. Further, the font may have a particular size. Attached hereto is an Exhibit showing that visually demonstrates the relationships between different typefaces, different weights of the typefaces, and different font sizes. As noted at the top of the Exhibit, the fonts shown thereon are 36 point, which is the “font size.” The font size could, of course, be adjusted larger or smaller. The Exhibit further shows two different fonts, namely Gothic and Mincho typefaces. Within each of the two typefaces, there are different weights, i.e., W3, W5, and W7, with W7 being the thickest. Note that reducing a font size would not necessarily result in thinning its weight, e.g., a 36 point font with a weight of W3 may be thinner than a 12 point font with a weight of W7.¹

With this difference between font size, font typeface, and font weight in mind, Applicants again submit that Cedar et al. does not disclose or suggest the feature of independent claims 20, 24, and 28 of the selecting a font with the thinnest weight in a specified typeface if the font size is smaller than a first size and is larger than or equal to a second size. The disclosure of the reference cited in the Office Action of a user selecting a font size, not a weight, does not expressly meet this selecting feature of the claims. Further, the Office Action’s reasoning that changing the font size would necessarily change the weight of a current font to the thinnest possible weight is not correct. At any given font

^{1/} Applicants again note that the terminology of font sizes, font typefaces, and font weights, all have clearly-defined meanings to those skilled in the art, as discussed in the response to the Section 112 rejection.

size, i.e., 12 point, 16 point, 36 point, etc., the font may have different weights, i.e., W3, W5, W7, etc. Simply changing the font size would not result in any particular change in font weight, and certainly could not be taken to necessitate a change to the thinnest weight. Thus, Cedar et al.'s mere disclosure of changing a font size cannot be understood to expressly or inherently anticipate the claimed feature of selecting a font with the thinnest weight in a specified typeface if the font size is smaller than a first size and is larger than or equal to a second size.

Applicant further submits that the other citations to Hino, Yudasaka et al., Sakurai, and Hertzfeld fail to cure the deficiencies of Cedar et al. That is, none of the other references disclose or suggest the feature of the claims of selecting a font with the thinnest weight in a specified typeface if the font size is smaller than a first size and is larger than or equal to a second size.

Thus, for at least the foregoing reasons, Applicant submits that the references cited in the Office Action fail to disclose or suggest the claimed invention.

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In view of the foregoing amendments and remarks, it is respectfully submitted that the pending claims are allowable over the references of record, and that the application is in condition for allowance. Favorable reconsideration and early passage to issue of the application are earnestly solicited.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

/Donald H. Heckenberg, Jr./

Donald H. Heckenberg, Jr.
Attorney for Applicant
Registration No.: 60,081

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
Facsimile: (212) 218-2200

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